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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,270	03/21/2001	Peter Hans Edlund	34648-00446USPT P13307US	3974
27045	7590	06/14/2004	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			CHO, UN C	
			ART UNIT	PAPER NUMBER
			2682	7

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,270

Applicant(s)

EDLUND ET AL.

Examiner

Un C Cho

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2 and 3</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
Page 5, line 5 and Page 7, line 11 recites "UTMS" it should be UMTS instead.
Appropriate correction is required.

Drawings

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 3, 5 – 7, 9, 10, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (US 5,839,070) in view of Moore (US 6,501,951).

Regarding claim 1, Lupien teaches a method in a telecommunication network for downloading information to a selected mobile station, the telecommunication network associated with a number of first cells in a location area, wherein each first cell is associated with a first communication system,

wherein a given first cell has a neighboring second cell associated with a second communication system (Lupien, Fig. 1), and wherein both multimode and single mode mobile stations disposed to enter and move through the location area into proximate relationship with the given first cell (Lupien, Col. 6, lines 1 – 8), inherently receiving a registration procedure request from the selected mobile station capable of communicating with both the first and second communication system (Lupien, Col. 6, lines 18 – 23); providing notice of the neighboring second cell to the selected mobile station in response to the registration procedure request if the selected mobile station is a multimode mobile station (Lupien, Col. 8, lines 24 – 28). However, Lupien fails to teach withholding the notice of the neighboring second cell from the selected mobile station if the selected mobile station is only capable of communicating with the first communication system. In contrast, Moore teaches that if the mobile station is only capable of communicating with the primary system withholding the notice of the neighboring second cell (private systems) from the selected mobile station (Moore, Col. 2, line 65 through Col. 3, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Moore to Lupien to provide further controls in the re-selection process to avoid the attempt to re-select to incompatible control channels, also to avoid second attempts to re-select to control channels which are determined to be incompatible with the mobile station during a re-select attempt.

Regarding claim 2, Lupien as modified by Moore teaches that the selected mobile station commences measurements directed to the second cell in response to the notice (Lupien, Col. 8, lines 38 – 41).

Regarding claim 3, Lupien as modified by Moore teaches transmitting a flag to the mobile station (Moore, Col. 4, lines 21 – 22 and lines 45 – 46).

Regarding claim 5, Lupien as modified by Moore teaches downloading a list of first cells, which respectively have second cell neighbors to the selected mobile station (Lupien, Col. 8, lines 24 – 28).

Regarding claim 6, Lupien as modified by Moore teaches that the list is downloaded to the selected mobile station in connection with a location area updating procedure that starts when the selected mobile station enters the location area (Lupien, Col. 7, lines 46 – 57).

Regarding claim 7, Lupien as modified by Moore teaches supplying a list of first cells in the location area to the selected mobile station (Lupien, Col. 8, lines 24 – 28); and downloading a pointer to the selected mobile station to identify first cells on the list which respectively have neighboring second cells (Moore, Col. 4, lines 21 – 22 and 45 – 46).

Regarding claim 9, Lupien as modified by Moore teaches transmitting a flag to the selected mobile station (Moore, Col. 4, lines 21 – 22 and 45 – 46) to direct the selected mobile station to generate a download request message (Lupien, Col. 7, lines 46 – 57) and downloading information pertaining to the

second cell in response to the download request message (Lupien, Col. 8, lines 24 – 28).

Regarding claim 10, Lupien as modified by Moore teaches that the specified information comprises intersystem cell reselection parameters, which are downloaded to the selected mobile station by means of a MM specific procedure (Lupien, Col. 7, lines 34 – 37 and 39 – 45).

Regarding claim 13, Lupien as modified by Moore teaches that the network downloads a list of neighboring cells in the location area to the mobile station during a location updating procedure (Lupien, Col. 7, line 66 – Col. 8, line 4).

Regarding claim 21, the claim is interpreted and rejected for the same reason as set forth in claim 3.

5. Claims 4, 8, 11 – 12, 15 – 16, 18 – 20 and 22 - 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Moore as applied to claim 1 above, and further in view of Korpela (WO 99/01005).

Regarding claim 4, Lupien as modified by Moore teaches the flag (Moore, Col. 4, lines 21 – 22 and lines 45 – 46). However, Lupien as modified by Moore fails to teach that the flag comprises a single bit transmitted to the selected mobile station by means of a BCCH carrier. In contrast, Korpela teaches transmitting to the selected mobile station by means of a BCCH carrier (Korpela, Page 3, lines 10 – 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of

Korpela to Lupien and Moore to provide data transfer resources for finding a suitable new cell more efficiently.

Regarding claim 8, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 11, Lupien as modified by Moore teaches the limitations of claim 1. However, Lupien as modified by Moore fails to teach that the first communication system comprises the GSM and the second communication system comprises the UMTS. In contrast, Korpela teaches that the first communication system comprises the GSM (Fig. 2, 21a and 22a) and the second communication system comprises the UMTS (Fig. 2, 23a, 24a, 25a and 26a) (Korpela, Page 6, lines 10 – 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Korpela to Lupien and Moore to provide data transfer resources for finding a suitable new cell more efficiently.

Regarding claim 12, Lupien as modified by Moore and Korpela teaches that the specified information comprises information needed by the selected mobile station to prepare for handover and cell reselection (Lupien, Col. 8, lines 1 – 14) from the GSM system to the UMTS system (Korpela, Page 6, lines 10 – 12).

Regarding claim 15, Lupien as modified by Moore and Korpela teaches that the registration procedure is location updating performed when the selected mobile station enters the location area (Lupien, Col. 7, lines 46 – 57).

Regarding claim 16, Lupien as modified by Moore and Korpela teaches downloading UMTS neighboring cell information (Korpela, Page 6, lines 10 – 12) for the location area to the selected mobile station (Lupien, Col. 8, lines 24 – 28).

Regarding claim 18, Lupien as modified by Moore and Korpela teaches that the UMTS neighboring cell information (Korpela, Page 6, lines 10 – 12) includes information about a service capability of UMTS cells (Lupien, Col. 5, lines 38 – 42).

Regarding claim 19, Lupien as modified by Moore and Korpela teaches downloading a list (Lupien, Col. 8, lines 24 – 28) of GSM cells that have UMTS neighbors (Korpela, Page 6, lines 10 – 12).

Regarding claim 20, Lupien as modified by Moore and Korpela teaches that additional UMTS neighboring cell information is downloaded to the selected mobile station upon the mobile station performing location updating (Lupien, Col. 7, line 66 – Col. 8, line 4) based on the pre-stored list of GSM cells that have UMTS neighbors (Korpela, Page 6, lines 10 – 12).

Regarding claim 22, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 23, the claim is interpreted and rejected for the same reason as set forth in claim 4.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Moore as applied to claim 1 above, and further in view of Cudak et al. (US 5,862,452).

Regarding claim 14, Lupien as modified by Moore teaches downloading specific information to the mobile station by means of a MM specific procedure (Lupien, Col. 7, lines 34 – 37 and 39 – 45). However, Lupien as modified by Moore fails to teach that the downloading of specified information comprises frequency and scrambling code combinations for each second cell within the location area. In contrast, Cudak teaches downloading frequency hopping table and scramble code index to the peripheral device (Cudak, Col. 45, lines 1 – 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Cudak to Lupien to Moore to provide low complexity dynamic persistence for random access by a peripheral device in a wireless communication system.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien in view of Moore and Korpela as applied to claim 16 above, and further in view of Cudak (US 5,862,452).

Regarding claim 17, Lupien as modified by Moore and Korpela teaches the UMTS cell information, together with intersystem cell reselection parameters for all UMTS neighboring cells within the location area. However, Lupien as modified by Moore and Korpela fails to teach that the neighboring cell information includes frequency and scrambling code combinations. In contrast, Cudak teaches downloading frequency hopping table and scramble code index to the peripheral device (Cudak, Col. 45, lines 1 – 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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provide the teachings of Cudak to Lupien, Moore and Korpela to provide low complexity dynamic persistence for random access by a peripheral device in a wireless communication system.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703)305-8725. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703)308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LEE NGUYEN
PRIMARY EXAMINER

Un C Cho *UC* 6/7/2004
Examiner
Art Unit 2682